

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* PODUTOORI R. REDDY, ROBERT A. MADSEN  
and JOHANNES H. SCHUURMAN

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Appeal No. 1998-2229  
Application 08/491,663

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ON BRIEF

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Before PAK, OWENS and LIEBERMAN, *Administrative Patent Judges*.  
OWENS, *Administrative Patent Judge*.

*DECISION ON APPEAL*

This is an appeal from the examiner's refusal to allow claims 1-6 as amended after final rejection. Claims 7-12, which are all of the other claims in the application, have been indicated allowable by the examiner.

*THE INVENTION*

The appellants claim a fat continuous stick product,  
e.g., margarine, made by a recited process. Claim 1 is  
illustrative:

1. A fat continuous stick product having up to 80% of a fat containing less than 10% trans fatty acids prepared by a process comprising the steps of:

(1) selecting a structuring amount of a hardstock fat to make a stick product, the hardstock fat having a level of trans fatty acids not exceeding 10% and prepared by randomly interesterifying a mixture containing 30-75 wt.% of an oil(i) in which at least 20% of the fatty acids residues consist of linoleic acid and 25-70 wt.% of a fat (ii) in which at least 80% of the fatty acid residues is saturated and has a chain link of at least 16 carbons and then fractionating the interesterified mixture to obtain an olefin fraction having a solid fat content of:

$$N_{10} = 22-80,$$

$$N_{20} = 8-60,$$

$$N_{30} = 1-25,$$

$$N_{35} = 0.15;$$

(2) selecting an effective amount of an oil which is liquid at room temperature selected from the group consisting of soybean oil, sunflower oil, fish oil, rapeseed oil, coconut oil, peanut oil, palm oil, corn oil, sesame oil, sardine oil, lard, tallow and mixtures thereof;

(3) combining the hardstock fat of step (1) and the liquid oil of step(2) to form a fat phase;

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(4) preparing an aqueous phase to combine with the fat phase of step (3) to provide a stick product having from 30-80% fat in the total composition;

(5) introducing the aqueous phase and the fat phase into a scrapped surface heat exchanger unit to form a cooled emulsion from the fat phase and aqueous phase wherein the cooled emulsion has an exit temperature of less than 20EC;

(6) passing the cooled emulsion into a crystallizing (C-unit) unit having an exit temperature of C-unit greater than the exit temperature of the cooled emulsion and the crystallizing unit having a shear rate of less than 1800 rpm to aid in forming a finer dispersion and to initiate crystallization in the cooled emulsion; and

(7) passing the cooled emulsion with the fat crystals into a second scrapped surface heat exchanger unit having a temperature range of at least 2-8EC below the exit temperature of the cooled emulsion,

wherein the residence time of the process is less than ten minutes to form a fat continuous stick product which stands upon its own weight and has a mean aqueous phase droplet size distribution d3.3 of less than 10 microns and has a C-valve of between 800 and 1579.

#### THE REFERENCES

Milo et al. (Milo) 5,169,668 Dec. 8, 1992

Frank D. Gunstone and Frank A. Norris (Gunstone), *Lipids in Foods Chemistry, Biochemistry and Technology* 147-55 (Pergamon Press 1983).

G.R. List et al. (List), "Preparation and Properties of Zero Trans Soybean Oil Margarines", 72 JAOCS 383-84 (1995).

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#### *THE REJECTION*

Claims 1-6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gunstone in view of Milo and List.

#### *OPINION*

We reverse the aforementioned rejection. We need to address only claim 1, which is the sole independent claim.

The examiner relies upon Gunstone for the following disclosures: stick margarine having a minimum of 80% fat (page 147), various combinations of fat products for use in stick margarines (page 153), solids/fat indexes of stick margarines (page 154), interesterification, direct blending of natural fats, and combining fat and water phases as an emulsion (page 153), pumping the emulsion into a hold tank which feeds Votator A and then B units (page 153), and tempering the product (pages 153-54) (answer, pages 5-6).

The examiner argues that Gunstone differs from the appellants' claimed stick product in that Gunstone does not disclose processing fats in a C-unit and does not disclose a fat containing less than 10% trans fatty acid (answer, pages

5-6). The examiner relies upon Milo for a teaching of using a C-unit for crystallization and phase inversion of a water-in-oil emulsion in the production of edible spreads (col. 1, lines 6-21), and List for a disclosure of a stick margarine with zero trans interesterified fats (page 383) (answer, pages 5-6).

The appellants argue that List's interesterified soy bean oil-trisaturate blends are outside the scope of the oil-fat blends encompassed by the appellants' claims (brief, page 12). The examiner argues that modifying List's composition such that the appellants' composition is obtained would have been within the ability of one of ordinary skill in the art (answer, page 6). The relevant issue regarding obviousness, however, is not whether one of ordinary skill in the art would have had the ability to modify the List composition such that the appellants' composition is obtained but, rather, whether the applied prior art would have provided one of ordinary skill in the art with both a suggestion to make that modification and a reasonable expectation of success in doing so. *See In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d

1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." *Id.* The mere possibility that the prior art could be modified such that the appellants' product is produced is not a sufficient basis for a *prima facie* case of obviousness. See *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996); *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995). The examiner has not set forth the required explanation as to why the applied prior art would have provided one of ordinary skill in the art with both a suggestion to modify List's composition so as to arrive at the appellants' composition, and a reasonable expectation of success in doing so.

The appellants argue that the recitation of a product C value between 800 and 1579 limits the product to a texture which is not suggested by the applied prior art (brief, page 13). The examiner argues that optimizing the texture is within the general determination and taste of one of ordinary skill in the art (answer, pages 6-7). The examiner, however, has provided no reason as to why the applied prior art would

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have fairly suggested that particular texture to one of ordinary skill in the art and provided such a person with a reasonable expectation of success in modifying the applied prior art to obtain it. See *Dow Chemical Co.*, 837 F.2d at 473, 5 USPQ2d at 1531.

As correctly pointed out by the examiner (answer, page 5), the appellants claim a product and not a process. The examiner, however, has not carried the burden of explaining why a product having the characteristics recited in the appellants' claim 1 would have been fairly suggested to one of ordinary skill in the art by the applied references. Accordingly, we reverse the examiner's rejection.

## DECISION

The rejection of claims 1-6 under 35 U.S.C. § 103 over Gunstone in view of Milo and List is reversed.

REVERSED

CHUNG K. PAK )  
Administrative Patent Judge )  
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	TERRY J. OWENS	)	BOARD OF
PATENT			
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
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		)	
	PAUL LIEBERMAN	)	
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